REMARKS

Claims 1-10, 12-17 and 19-22 are pending in the current application. Of those, claims 1, 12, and 19 are independent claims. Claims 11 and 18 remain canceled. No new claims are added by this Response.

Drawings

The Drawings stand objected to under 37 C.F.R. § 1.83(a). The Office Action asserts that the drawings must show every feature of the invention specified in the clams. In particular, it asks that the claim 1, 12, and 19 feature, "[...] a token including a plurality of bits, each bit associated with a different parameter group type [...]," must be shown in the drawing or canceled from the claim(s).

The Office Action does not correctly apply 35 U.S.C. § 113. The Examiner is reminded that under federal law, the applicant is required to furnish a drawing only when it is necessary for the understanding of the subject matter to be patented. See 35 U.S.C. § 113. Only when this threshold is met must the applicant then submit a "complete illustration" as defined by 37 C.F.R. § 1.83(a). MPEP § 608.02. A "complete illustration" requires the drawings to illustrate every <u>feature</u> of the claimed subject matter. "When evaluating whether the drawing has met the statutory requirement, it is essential [to] consider what the drawing convey[s] to a person of ordinary skill in the art [...]." <u>Trilithic, Inc. v. Wavetek U.S., Inc.</u>, 64 F.Supp. 2d 816, 820 (S.D. Ind. 1999).

The Office Action states that the feature "a token including a plurality of bits, each bit associated with a different parameter group type" must be shown or the feature(s) canceled from the claim(s). The examiner misstates the claim feature, which properly reads "[...] wherein the token includes a plurality of bits, each bit associated with a different parameter group type." 10/084,174 cl. 1 and 12. The Examiner is

directed to FIG. 1 which indicates the feature TOKEN. The applicant respectfully submits that the feature is present in the drawing. This is a "complete illustration" of the claims. It is not necessary to include a verbal description of the the "wherein" clause for a person of ordinary skill in the art to understand the drawing, as required by 35 U.S.C. § 113.

Claim Objections

Claims 4-9, 12-17 and 20-22 stand objected to because of informalities. Said objections have been taken into consideration, and claims 4 and 12 are amended pursuant to the directions in the Office Action. In particular, the feature "the accessed parameter group" is changed to "the stored parameter group," which has proper antecedent basis.

Claims Rejections – 35 U.S.C. § 112

Claims 1-10, 12-7 and 19-22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Office Action rejects independent claims 1, 12, and 19 on the grounds that the feature "without sending the parameters for the associated one of the parameter group types to the access terminal" is not supported by the specification. The Office Action (1) does not take into account that said feature was adopted at the Examiner's direction, (2) does not establish adequate grounds for a § 112 ¶1 rejection, and (3) fails to consider that a specification may implicitly support a claim.

The Examiner is reminded that the abovementioned rejected feature was added based on the Examiner's own recommendations. The Examiner is referred to the March 20, 2008 Interview Summary. During the Examiner Interview on March 11,

2008, the <u>Examiner agreed</u> to the abovementioned feature in order to overcome, among other things, the Tuunanen reference, U.S. Patent No. 6,487,288.

The Applicant was, and still is, of the opinion that said feature was not needed. The feature "without negotiating parameters for the associated parameter group" implicitly conveys to one skilled in the art "without sending the parameters for the associated one of the parameter group types to the access terminal." This is further discussed below. Nonetheless, the Applicant agreed to add said feature, pursuant to the Examiner's directions, to clarify the claim for the Examiner and place the claim in allowable form. Thus, Applicant respectfully requests that the rejections of these claims under 35 U.S.C. §112 be withdrawn.

In any event, said feature is indeed supported by the specification. The Examiner is reminded that to satisfy "the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP § 2163; 35 U.S.C. § 112, ¶ 1. There is no *haec verba* requirement, which means new or amended claims may be supported in the specification through implicit or inherent disclosure. <u>See</u> MPEP § 2163.02. Thus, "[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." MPEP § 2163 (citing <u>Vas-Cath, Inc. v. Mahurkar</u>, 935 F.2d 1555, 1563 (Fed. Cir. 1991).).

In applying the abovementioned principles, the Examiner is further reminded that "[a] description as filed is presumed to be adequate, unless or until <u>sufficient evidence or reasoning</u> to the contrary has been presented by the examiner to rebut the presumption." MPEP § 2163.07. "The examiner has the initial burden of presenting by

a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." Id.

The Office Action rejects claims 1 and 19 on the grounds that the feature "without sending the parameters for the associated one of the parameter group types to the access terminal" is not supported by the specification. The Office Action cites: (1) page 2, lines 13-19, and (2) page 4, lines 14-21. Thereafter Office Action makes the following conclusory statement:

> The specification discloses of without negotiating a parameter group when the portion of the access terminal operates according to the default parameter group for the parameter group type. However, the specification does not specifically describe of "without sending the parameters for the associated one of the parameter group types to the access terminal" when the access terminal operates according to the default parameter group as recited in claims 1 and 19.
> 06/06/08 Office Action ¶ 9 (emphasis added)

The Office Action fails to correctly apply 35 U.S.C. § 112 ¶1. It requires the specific recitation of the claim feature in the specification, contrary to the MPEP which makes clear that there is no *haec verba* requirement. MPEP § 2163.02. In addition, the two sentences long reasoning is not adequate or sufficient reasoning to overcome, by a preponderance of the evidence, the presumption that there is adequate description. Also, the evidence forwarded (page 2, lines 13-19, and page 4, lines 14-21) are neither adequate or sufficient to overcome the presumption for the reasons discussed below.

The specification does, in fact, have an implicit/inherent disclosure of the claim feature. The specification defines the term 'negotiation of the parameters' as "communication of messages from the access network and the confirmation responses from the access terminal." 10/084,174 p. 1, ln. 28. Parameters govern the communication between the access terminal and access network. Id. at p. 1, ln. 13.

Page 12

The 'negotiation' takes place when access network parameters and access terminal parameters do not coincide. Id. at p. 1, ln. 19-22. Subsumed in the negotiation of parameters is sending the parameters for the associated parameter group type to the access terminals. In particular, the messages from the access network to the access terminal may include the "parameters for the associated parameter group type to the access terminals." Thus, implicit in the feature "without negotiating parameters for the associated parameter group" is "without sending the parameters for the associated one of the parameter group types to the access terminal." This is further underscored in the example embodiments. In one example embodiment, it is implied that no parameters "for the associated one of the parameter group types" are sent if a token, associated with a default parameter group, is not null. 10/084,174 p. 4, ln. 5-25. In another example embodiment, it is implied that no parameters "for the associated one of the parameter group types" are sent if the access network determines that a stored parameter group matches a non-default parameter group. Id. at p. 5, ln. 5-13. These example embodiment are encompassed by claims 1, 12, and 19.

Therefore, Applicant respectfully requests that the rejections of these claims under 35 U.S.C. §112 be withdrawn.

Claims Rejections – 35 U.S.C. § 103: Oyama and Rasanen

Claims 1-3 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama et al. (US 2002/0114305, hereinafter "Oyama") in view of Rasanen (US 2005/0286418, hereinafter "Rasanen").

i. Oyama does not teach all the cited features

The Examiner is reminded that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed subject

matter as a whole would have been obvious. MPEP § 2141.02. Thus, a prior art

reference must be considered in its entirety, i.e., as a whole, including portions that

would lead away from the claimed invention. Id. Furthermore, "[a]ll words in a claim

must be considered in judging the patentability of that claim against the prior art."

MPEP § 2143.03.

The Office Action asserts that paragraphs [0043], [0044], [0068], [0077], and

[0085] of Oyama read on the following claim element:

> Receiving, at an access network, an access request
> and a token from an access terminal, the token
> including at least one bit associated with a
> parameter group type, the at least one bit indicating
> whether the terminal is operating according to a
> default parameter group for the associated parameter
> group type. 10/084,174, cl. 1.

Oyama recites sending a message to a bearer in order to set up a connection

between two points. Paragraph [0043] of Oyama reads:

> A message requesting a bearer to support
> communication between a mobile terminal and an
> access point to a packet data network is generated.
> That message includes a signaling QoS indicator,
> which when detected, causes a bearer to be
> established between the mobile terminal and the
> access point in accordance with the pre-established
> signaling QoS profile. Oyama para. [0043] (emphasis
> added)

A bearer is defined by Oyama as "[...] a logical connection between two entities

through one or more interfaces, networks, gateways, etc., and usually corresponds to

a data stream or data flow." Id. at para. [0012]. Thus, a bearer is an intermediate

connection between a terminal and a network, i.e. a node. The message sent in

Oyama is to this intermediary.

Further, the message itself includes a "signaling QoS indicator." Id. Each

node/bearer has a pre-established signaling QoS profile. Id. at [0044] (One of the

benefits of the signaling QoS profile being already configured in the nodes in an access

network is the quality of service for such a bearer requesting that signaling QoS profile need not be negotiated during the setup of the session[...]). The signaling QoS indicator identifies a preexisting connection from the signaling QoS profile.

Contrary to the Examiner's position, Oyama does not teach claims 1, 12, and 19. The feature "receiving, at an access network, an access request and a token from an access terminal" is not present. First, the message in Oyama is received by a bearer, while the claimed subject matter expressly requires the access network to receive the 'message.' A bearer is an intermediary node that helps set up a connection, while an access network is a destination point. Second, the message sent in Oyama is a signaling QoS indicator. The signaling QoS indicator identifies pre-established information in a bearer/node, not pre-established information in an access network. Furthermore, the signaling QoS indicator is not a token defined in bits, much less does it have "at least one bit associated with a parameter group type."

Thus, the applicant respectfully submits that Oyama does not teach all the features alleged to be taught by the Office Action.

ii. The Office Action relies on a Conclusory Statement to Find Obviousness

The Office Action fails to establish a prima face § 103 rejection. After presenting the Rasanen and Oyama references, the Office Action states:

> Oyama teaches a plurality of QoS parameters associated with a QoS profile and teaches of the mobile node specifying settings varying from the pre-established QoS profile (Paragraph 0103). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings from the message to indicate QoS as taught by Oyama by including a bit associated with a parameter as taught by Rasanen for the plurality of QoS parameters, which would enable Oyama's system to establish a session with specific pre-established QoS parameter.
>
> 06/06/08 Office Action ¶ 17 (emphasis added).

The Examiner is reminded that a <u>mere statement</u> that modifications of the prior art would have been "well within the ordinary skill of the art" because "the references relied upon teach that all aspects of the claimed invention were individually known in the art <u>is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.</u>" MPEP 2143. Thus "[...] rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." <u>Id.</u> (citing <u>KSR International Co. v. Teleflex Inc.</u>, 82 USPQ2d 1385, 1396 (2007).).

Additionally, "[a] rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods <u>with no change in their respective functions</u>, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art." MPEP § 2143 (citing <u>KSR</u>, 82 USPQ2d at 1395.).

The abovementioned citation does not give any reasoning as to why the Rasanen and Oyama references should be combined. As stated above, Oyama teaches a system in which a message is sent to bearer/nodes in order to create a connection between a terminal and a network endpoint. Rasanen teaches a data link method with an interworking IWF function that allows an end-to-end link to exchange data compression parameters. <u>See</u> Rasanen Abstract. Further, the bit values in Rasanen correspond with the type of data compression to be done in the end-to-end link. Rasanen para. [0053].

The Office Action does not state how the Rasanen bit values (corresponding with data compression) can be combined with the Oyama message (sent to bearer/nodes) to make a token bit message sent to an access terminal. Such a

combination would change the function of the invention disclosed in Oyama. If the message sent to the nodes in Oyama were bit values corresponding to data compression, then the Oyama invention would be inoperable, as the bit values would not correlate with the signaling QoS profile already stored in the nodes. Oyama para. [0044]. Thus, there is no reasonable expectation of success, since combining said reference would inevitably require a substantial change in the operation of the invention disclosed in Oyama, contrary to MPEP § 2143.

Therefore, Applicant respectfully requests that this art ground of rejection of claims Claims 1-3 and 19 under 35 U.S.C. §103 be withdrawn.

Claims Rejections – 35 U.S.C. § 103: Oyama, Rasanen, and Immonen

Claims 4, 7, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama and Rasanen, in view of Immonen et al. (US 2002/0132611, hereinafter "Immonen").

Applicant respectfully submits Immonen at least fails to cure the deficiencies of Oyama and Rasanen articulated above. Therefore, applicants request the rejection of claims 4, 7, 12, and 15 be withdrawn for failure to teach the above discussed claim feature common to independent claims 1, 12, and 19.

Claims Rejections – 35 U.S.C. § 103: Oyama, Rasanen, Immonen and Balazinski

Claims 5-6, 8-9, 13, 14, 16, 17, and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama, Rasanen, and Immonen, in view of Balazinski et al. (US Publication No. 2002/0097707, hereinafter "Balazinski").

Applicant respectfully submits Immonen and Balazinski at least fail to cure the deficiencies of Oyama and Rasanen articulated above. Therefore, applicants request the rejection of claims 5-6, 8-9, 13, 14, 16, 17, and 20-22 be withdrawn for failure to teach the above discussed claim feature common to independent claims 1, 12, and 19.

Claims Rejections – 35 U.S.C. § 103: Oyama, Rasanen and Balazinski

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama and Rasanen, in view of Balazinski.

Applicant respectfully submits Balazinski at least fails to cure the deficiencies of Oyama and Rasanen articulated above. Therefore, applicants request the rejection of claim 10 be withdrawn for failure to teach the above discussed claim feature common to independent claims 1, 12, and 19.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the claims in connection with the present application is earnestly solicited.
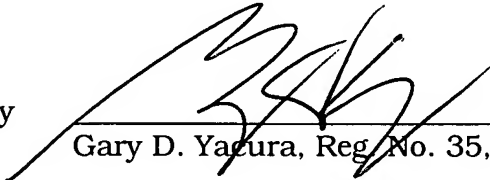
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By _____
Gary D. Yacura, Reg. No. 35,416

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

GDY/JJH